

REMARKS/ARGUMENTS

Claims 1-20 are pending in the application and stand rejected in the Final Office Action of July 30, 2007.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-2, 11-12, and 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotenberg et al, "Trace Cache: a Low Latency Approach to High Bandwidth Instruction Fetching" (hereinafter "Rotenberg"). Claims 3, 13, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotenberg, in view of U.S. Patent No. 6,304,962 (hereinafter "Nair"). Claims 4-5, 14-15, and 19-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotenberg in view of Nair in view of "Trace Cache Design for Wide-Issue Superscalar Processors" (hereinafter "Patel"). Claims 6-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotenberg in view of "Structured Computer Organization," 1984. Pg. 10-11 (hereinafter "Tanenbaum"). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotenberg in view of Nair and in view of Tanenbaum. Claims 9-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotenberg in view of Nair and in view of Patel and in view of Tanenbaum.

Page 4 of the Office Action dated July 30, 2007 states that "Rotenberg does not teach that the multiple traces have a same beginning instruction," but that it does teach how such features would be advantageous. As applicant noted in his previous response dated June 4, 2007, the mere fact that a reference speculates as to future developments in the art does not mean that it teaches those future developments for purposes of anticipation. "To anticipate, the reference must . . . enable one of skill in the art to *make and use* the claimed invention." Bristol-Myers

Squibb Co. v. Ben Venue Labs., Inc., 58 U.S.P.Q.2d 1508, 1512 (Fed. Cir. 2001) (emphasis added). The Rotenberg reference is not an enabling reference as it relates to path associativity because although it mentions path associativity as being a possible aspect of a future embodiment, it is silent regarding how to implement it into a trace cache, and none of the additional references cited cure this deficiency. Although page 2 of the Office Action dated July 30, 2007 states that “one having ordinary skill in the art would be able to implement path associativity into a trace cache,” the Office Action does not cite to any references teaching path associativity and does not provide any evidence supporting its assertion regarding the state of the art at the time the present application was filed. The Office Action, therefore, fails to make a *prima facie* case of obviousness.

Additionally, the Office Action proffers no explanation as to how Rotenberg teaches or even suggests “selecting a trace from among the multiple traces based on the branching behavior of the first previous set of branching instructions” as claimed in applicant’s independent claim 1. The cited portion of Rotenberg says nothing more than it “might be advantageous to be able to store multiple paths emanating from a given address” in order to reduce thrashing. It does not teach how to select among those paths after they are stored. Therefore, for at least all the reasons discussed above, applicant asserts Rotenberg, either alone or in combination with the other cited reference, does not teach all the elements of independent claim 1 or independent claims 6, 11, and 16 which contain limitations similar to that of claim 1. Applicant further asserts that dependent claims 2-5, 7-10, 12-15, and 17-20 are allowable as depending from allowable independent claims. Accordingly, applicant respectfully requests the rejection of claims 1-20 under 35 U.S.C. § 103(a) be withdrawn, and a notice of allowance is earnestly solicited.

The Commissioner is hereby authorized to charge payment of any additional fees and/or

patent application processing fees required under 37 C.F.R. § 1.16 and § 1.17 or credit any
overpayment to Deposit Account No. 11-0600

Respectfully submitted,

KENYON & KENYON LLP

Dated: October 1, 2007

By: /Jeffrey R. Joseph/
Jeffrey R. Joseph
(Reg. No. 54,204)

KENYON & KENYON LLP
333 W. San Carlos, Suite 600
San Jose, CA 95110

Telephone: (408) 975-7500
Facsimile: (408) 975-7501